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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,617	08/01/2001	Kouji Watanabe	Q63879	2505

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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
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Washington, DC 20037-3213

EXAMINER

LIN, WEN TAI

ART UNIT	PAPER NUMBER
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2154

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/919,617

Applicant(s)

WATANABE, KOUJI

Examiner

Wen-Tai Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 7-32, 34 and 36-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7-32, 34 and 36-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-3, 5, 7-32, 34, and 36-48 are presented for examination.
2. Applicant is reminded of a "whereby" clause in claim 2. The determination of whether the whereby clauses is a limitation in a claim (see claim 2) depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby" clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.
3. Claims 25 and 48 are objected to because of the following informalities: (1) there appears to have typos in claim 25, line 13; and (2) the term "the high orderer" in claim 48 either contains typographical error or lack antecedence basis.
4. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

Claim Rejections - 35 USC 102

5. Claims 1-3, 5, 7-32, 34 and 36-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Parulski[U.S. PGPub 20050213146].

6. As to claims 1-3, 5 and 7-9, Parulski teaches the invention as claimed including:
a method for contents data processing service, comprising the steps of:

transferring contents data from a terminal of an orderer to a processing apparatus of an order receiver via a communication line, which can be in the Internet [Abstract; 42, Fig.1];

processing said transferred contents data in said processing apparatus of the order receiver; and

transferring processed contents data from said processing apparatus of the order receiver to said terminal of the orderer via said communication line or storing and managing said processed contents data in a storage area of a data managing unit [20, Fig.3] that is accessible from at least one of said terminal of the orderer and a terminal of a third party via said communication line, or both of said transferring of said processed contents data and said storing and managing of said processed contents data [e.g., paragraph 36: "[a]lternatively, the user's image may be transferred via the ISP 30 and the channel 36 to the Internet Server 42 and processed. The "after processing" image can then be transferred from the Internet Server 42 to the user's computer 10 for viewing on the display monitor 14],

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wherein said contents data is digital image data, said processing performed in said processing apparatus of the order receiver is image processing, and said processed contents data is digital image data that has been subjected to image processing; wherein said image processing is high definition image processing performed by the order receiver; and wherein only said processing apparatus of the order receiver has a configuration performing said high definition image processing on said contents data [e.g., paragraphs 12-15 and 36; note that red-eye removal is a high definition processing].

7. As to claim 11, since the features of this claim can also be found in claims 1, 4 and 8, it is rejected for the same reasons set forth in the rejection of claims 1, 4 and 8 above.

8. As to claim 13, R3 further teaches that said edit processing information includes at least one of character composition processing, certificate photograph processing, calendar processing, album processing, post card processing, business card processing, ticket processing, menu processing, template composition processing, mini-frame processing, card print processing and free trimming processing [e.g., paragraphs 10-11 and 80].

9. As to claim 21, Parulski further teaches that said processing apparatus of the order receiver manages said orderer by an URL or an ID card [e.g., paragraph 27].

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10. As to claim 22, Parulski further teaches determining a fee for a processing service according to used processing items and a data amount of said contents data and determines a fee for storing said processed contents data according to a period using a server for storing and managing said processed contents data and an area of use of the server, and said order receiver is billed these fees added to a fee for using said communication line from a connection service company of said communication line [e.g., paragraphs 136 and 146].

11. As to claims 10, 12, 14-20, 23-32, 34 and 36-47, since the features of these claims can also be found in claims 1, 4-9, 11, 13, 21-22, 33 and 35, they are rejected for the same reasons set forth in the rejection of claims 1, 4-9, 11, 13, 21-22, 33 and 35 above.

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

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of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday (8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(571)273-8300 for official communications; and

(571)273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

January 10, 2007

Wen-Tai Lin
2/1/07